enabling a user to select at least one coupon type from a plurality of different coupon types, a selected coupon type corresponding to subject matter of interest to the user;

evaluating the extracted coupon data with the electronic coupon; and

if the extracted coupon data matches the selected coupon type, then storing the extracted coupon data, and otherwise, not storing the extracted coupon data.

30. (New) A method for delivering and storing coupon data using the horizontal overscan portion of a video signal, the method comprising the steps of:

providing an electronic coupon;

receiving the video signal during a transmission session;

extracting coupon data from the horizontal overscan portion of a video signal for input to the electronic coupon;

enabling a user to select a storage mode, such that when the storage mode is selected, the electronic coupon stores extracted coupon data; and

enabling a user to select a redeem mode, such that when the redeem mode is selected, the electronic coupon displays the extracted coupon data.--

23 Cont'd.

REMARKS

Status of the Claims

Claims 1-30 are now pending in the present application, new Claims 24-30 having been added in the present amendment. Claim 3 has been amended to correct a grammatical error.

Rejection of Claims 1-23 as Obvious over Mankovitz in view of Small

The Examiner has rejected Claims 1-23 under 35 U.S.C. § 103(a) as being obvious over Mankovitz in view of Small. The Examiner indicates that Mankovitz discloses storing coupon data in the vertical blanking interval (VBI) portion of a video signal, but admits that Mankovitz does not disclose the use of the horizontal overscan portion of a video signal. The Examiner relies upon Small for disclosing encoding audio signals between the horizontal blanking portion of a video signal and the visible image and concludes that it would have been obvious to modify Mankovitz to store coupon data between the horizontal blanking portion of a video signal and the visible image as disclosed by Small, to achieve the present claimed invention. Further, the Examiner asserts that combining Small and Mankovitz would have been obvious to one of ordinary skill in the art to avoid interfering with closed captioning data also encoded in the VBI of a video signal. Applicant respectfully disagrees for the following reasons.

Insufficient Motivation to Combine References as Suggested

While Mankovitz teaches storing and displaying coupon data obtained from a video signal, and Small teaches encoding audio data in the horizontal overscan portion of video signal, neither reference teaches or suggests the desirability of making a combination like that proposed by the

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Examiner. It is well established that to support *prima facie* obviousness, the cited prior art references must provide a motivation for combining the references. Since such motivation is not present in the cited prior art, *prima facie* obviousness is not justified. There is simply no reason why one of ordinary skill would be led to make the combination required to achieve the present claimed invention, other than hindsight, and the combination is therefore not obvious over these two references.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings to produce the claimed invention. Second, there must be a reasonable expectation of success in making such a combination. Finally, the prior art reference (or references when combined) must teach or suggest all elements or steps recited in the claim. *In Re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, with respect to determining obviousness, MPEP § 2141 indicates that the following basic considerations must be adhered to:

> (A) The claimed invention must be considered as a whole;
>
> ***(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;***
>
> ***(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and***
>
> (D) Reasonable expectation of success is the standard with which obviousness is determined. (Emphasis added.)

For the reasons set forth below, applicant submits that the prior art fails to establish a *prima facie* basis for the rejection of the claims, particularly in light of the considerations described in MPEP § 2141.

With respect to establishing some motivation for a combination of Mankovitz and Small, the Examiner appears to assert that some implied motivation existed because one of ordinary skill in the art would have desired to solve the problem of coupon data included in the VBI interfering with caption data, also included in the VBI. However, there does not appear to be any evidence supporting a conclusion that coupon data included in the VBI actually would interfere with caption data also included in the VBI. Nor does there appear to be any evidence supporting a conclusion that one of ordinary skill would have recognized such a problem needed to be solved. Merely because Mankovitz and Small both describe including non-video data in a video signal does not provide motivation to combine the references, as there does not appear to be any recognition of any problem such combination could solve.

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MPEP 2143 provides the following guidelines for establishing motivation.

> ***Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.*** "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). (Emphasis added).
>
> ***The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*** *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. ***Although*** a ***prior art*** device ***"may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*** 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references; emphasis added).
>
> A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab,* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (***Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention***); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). (Emphasis added).

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Clearly, the cited art does not provide any suggestion about the desirability, thus the obviousness, of a combination of Mankovitz and Small. It appears that the Examiner has concluded that obviousness can implicitly be shown. As the above citations from MPEP 2143 indicate, *In re Kotzab* describes an accepted test for an implicit showing. The test is described as what:

> *...a reasonable mind might accept as adequate to support implicitly the conclusion that a skilled artisan confronted with (1) the problem noted by Kotzab, i.e., providing optimal temperature control for an injection molding method to ensure the quality of the final product on the one hand, and achieving optimally short molding cycle times on the other hand, and (2) the two statements in Evans, would have been motivated to control a plurality of valves in a multiple zone setting with only one temperature sensor* (*In re Kotzab,* page 1318).

The court went on to conclude that:

> *In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting claims 1, 2, and 4-9 under 35 U.S.C. Section 103(a) over Evans* (*In re Kotzab,* page 1318).

In the present invention, Mankovitz teaches an electronic coupon that can store and display coupon data obtained from a video signal, and Small teaches encoding audio data in the horizontal overscan portion of video signal. As with the situation in *Kotzab*, while combining such elements might be simple in concept to one of ordinary skill in the art, there appears to be no specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with *no knowledge of applicant's invention* to make the combination in the manner suggested. Further, note that the prior art cited in *Kotzab* actually appeared to suggest (in an abstract of the cited art) the claimed invention of *Kotzab*, and in the present situation, no such suggestion is present. There is even less justification for making the combination in the present case than existed in the art cited in *Kotzab*, and in that case, it was determined that *prima facie* obviousness was not supported.

Mankovitz explicitly teaches that many different types of data can be included in the VBI of a video signal, but never indicates that data "crowding" in the VBI is a problem, or that different types of data (i.e., coupon data and caption data) interfere with each other. In fact, Mankovitz appears to

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believe that the bandwidth available in the VBI ***exceeds*** the quantity of data that can be beneficially displayed on a television screen along with a video image. Consider the following excerpts from Mankovitz:

> Decoders for data provided in the VBI are well known in the art and standards are being developed for data formats to usefully employ the VBI for transmission of additional data. *Typical uses of VBI data to date have been similar to closed captioning wherein data received in the VBI is decoded and provided as a separate video signal for printing of information to the television screen for viewing by the user.* Capability of prior art systems to decode, store and usefully employ data which can be provided in the VBI has been extremely limited (column 1, lines 22-31, emphasis added).
>
> Exemplary of data which may be provided in the VBI are channel specific program information such as short term upcoming program schedules and program related information such as statistics of baseball players during a baseball game, recipes provided during a cooking lesson, problem assignments and answers after an educational program and other related information displayed on the screen relevant to the program being viewed. *The majority of this type of information may be displayed or is desirable to be displayed concurrently with existing video programming.* Consequently, systems for decoding and presentation of the desired information rely on essentially identical technology to the closed caption systems previously described (column 1, lines 32-45,emphasis added).
>
> *Significant additional information may be disseminated through the use of VBI signaling, however, practical systems for storage and use of the data to be provided are not presently available.* Commercial information such as supplemental telephone number information, identification of local dealers and supplemental product/price information in addition to the video and audio presentation of a common television commercial are desirable. For greatest benefit this information should be available subsequent to the presentation of the video/audio commercial and should be stored for subsequent access and/or use. Merely overwriting the existing video of a commercial with additional information presented in the VBI produces no more favorable result for the advertiser than the materials in the commercial itself. Such information conveyed on video is fleeting and most viewers are not disposed to take any action while actually viewing a commercial. Transmission of data on the VBI which can be captured and displayed subsequently on the screen at the command of the user extends the usefulness of the real time broadcast adding "virtual time" in which potential customers may review important sales related information at their leisure. (Column 1, lines 45-67, emphasis added.)

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Contrary to the Examiner's assertion, Mankovitz appears to teach that the VBI can accommodate not only data that are to be displayed on a screen (captioning and other data), but as well can include additional data that are stored for later use. Given this teaching, it is not apparent why one of ordinary skill in the art would have believed that coupon data transmitted in the VBI of a video signal would interfere with captioning data, and therefore, it is not clear why one of ordinary skill would have been motivated to solve that problem. In fact, Mankovitz specifically describes an embodiment in which the VBI of a video signal includes captioning data, programming information, and commercial information (i.e., coupon data).

> VBI encoder/decoder systems are well known in the art and are presently employed for closed captioning for the hearing impaired. ***Formatting of specific data types for recognition by the microprocessor allows the data storage capability of the VBI to be employed for multiple uses.*** Various data provided in the vertical blanking interval may include program information for television programs being watched or taped. Commercial information, such as that previously described is also provided in the VBI data. The VBI decoder incorporates a multiplexer under the control of the microprocessor a logic means which segregates program information data from data applicable to the portable data coupon. (Column 6, lines 40-52,emphasis added.)

Because the cited art explicitly teaches that the VBI can accommodate multiple data types, there is simply no basis to conclude that one of ordinary skill in the art would have been motivated to combine the references in the manner suggested by the Examiner to solve the problem of including multiple types of data in the VBI.

The cited art does not teach the desirableness (thus the obviousness) of the suggested combination, nor is there any basis to conclude that the suggested combination solves any problem recognized in the art. Because it appears that the only motivation to combine the cited references is provided by a hindsight understanding of the benefits of the present invention, *prima facie* obviousness is not supported. Accordingly, the rejections of Claims 1-22 under 35 U.S.C § 103 as being obvious over Mankovitz in view of Small should be withdrawn.

Claim 2 Further Distinguishable over Mankovitz/Small Combination

Claim 2 specifically recites that the decoder that strips the coupon data from the video signal is integrated with the electronic coupon. Mankovitz does not teach or suggest a decoder that is integrated with the electronic coupon. In all embodiments disclosed by Mankovitz, the decoder and electronic coupon are separate components. The Examiner appears to assert that because the electronic coupon (i.e., portable data coupon 10) described by Mankovitz retrieves coupon data stored in RAM to be output to a display, the portable data coupon includes a decoder. Retrieving

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decoded coupon data stored in RAM is not equivalent to receiving a video signal containing encoded data and decoding the video signal to recover the encoded coupon data. Applicant's decoder, as defined by Claim 2, extracts coupon data from the horizontal overscan portion of a video signal during a transmission session. The only element described by Mankovitz that extracts coupon data from a video signal is controller 12. As explained by Mankovitz, when the read key is depressed and coupon data are retrieved from RAM, the data are simply being retrieved from storage. The coupon data are not extracted from the video signal in response to a user depressing any key on portable data coupon 10. Mankovitz explicitly states "VBI data is decoded from the television transmission signal by controller 12 which then transmits the data to the portable electronic coupon" (column 3, lines 46-48). Mankovitz goes on to explain that the data are transmitted via IR transmission, or a serial port connection. Mankovitz does not teach or suggest that the element that obtains the coupon data from the television signal is part of the electronic coupon.

Even if the teaching of Mankovitz and Small were combined in the manner suggested by the Examiner (and as described in detail above, there appears to be no motivation other than hindsight for such a combination), there is no basis to conclude that it would have been obvious to modify the separate portable data coupon (i.e., electronic coupon) and controller (i.e., decoder) to achieve the integrated electronic coupon/decoder recited by applicant. The cited art does not suggest the desirability of the modifications required to achieve the recited invention. Accordingly, the rejection of Claim 2 under 35 U.S.C § 103 as being obvious over Mankovitz in view of Small should be withdrawn.

Claims 9 and 10 Further Distinguishable over Mankovitz/Small Combination

Claim 9 specifically recites that the electronic coupon comprises a mode key, that enables a user to select either a storage mode or a redeem mode. Claim 10 specifically recites the mode key can be used to access a set-up mode. Mankovitz does not teach or suggest an equivalent mode key that toggles between storage and redeem modes. Mankovitz provides absolutely no disclosure about a set-up mode, and equivalents of the storage and redeem modes described by applicant are not taught or suggested in regard to the Mankovitz device.

Mankovitz clearly discusses the following keys: send key 30, read key 24, cancel key 26, save key 28, and alphanumeric keys 62. None of these keys provides the recited functionality, i.e. toggling between storage and redeem modes. While the Examiner is correct that save key 28 enables coupon data to be stored (a function similar to the recited storage mode), there is no basis to conclude that save key 28 enables a user to select a redeem mode. Mankovitz describes several redemption scenarios. A user can use read key 24 to cause a bar code to be displayed on screen 22, and that bar code can be scanned by a conventional bar code scanner, in much the same way a traditional paper coupon containing a bar code would be scanned.

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> The encoded data stripped from the VBI is retransmitted to the portable data coupon where it is stored in temporary memory as previously described. ***The coupon user may then retrieve the information from the memory through the use of the read key.*** Telephone numbers, addresses and similar information are decoded by the microprocessor and displayed on the portable data coupon for review by the user through the use of the read key. Electronic coupon information is displayed in one of several formats. An alphanumeric format showing the vendor/producer/dealer, amount of discount and expiration date allows the user to determine the value of the "electronic coupon." ***A standard UPC bar code format is alternatively presented on the display through predetermined key strokes on the existing keys or by way of a "shift" key (not shown) for use with redemption systems employing a laser scanner or similar system.*** The UPC bar code system allows easy comparison by automatic cash register systems of goods purchased. Such a bar code display is shown in FIG. 1B. (Column 5, lines 37-56, emphasis added.)

Alternatively, a supplemental adapter used in conjunction with a point of sale system enables the point of sale system to read the memory of portable data coupon 10, to match all stored coupons with purchases made. As described by Mankovitz, such a process does not require interaction by the user (other than ensuring that the supplemental adapter is either coupled to the portable data coupon 10 using a serial port, or that the units are disposed sufficiently close together to facilitate IR data transmission; see column 8, line 55 to column 9, line 14).

The Examiner even cites to column 8, lines 24-26, which specifically refer to FIG 1B and the excerpt above (from column 5, lines 37-56), which describes how the read key is employed in coupon redemption, by selection a specific coupon and displaying it as a UPC code to be scanned.

None of the keys described by Mankovitz has the functionality of switching between a storage mode and a redeem mode. As described in applicant's specification (page 9, second paragraph), when the storage mode has been selected, the electronic coupon can receive coupon data from the decoder. Depending on a configuration selected in a set up mode, either all coupon data are stored, or a processor evaluates each coupon as it is received, and saves only those coupons matching parameters defined by the user. In the redeem mode defined in applicant's specification (page 9, last paragraph through page 10, second paragraph), the user can scroll through all stored coupons, and select a specific coupon to display as a UPC code.

Thus, while the portable data coupon of Mankovitz and applicant's electric coupon are similar in storing and redeeming coupons, each device manages storage and redemption in patentably distinguishable ways. As described by Mankovitz, the portable data coupon is always storing data received from controller 12 (assuming the portable data coupon is in sufficiently close proximity to controller 12 and is properly positioned to facilitate IR transmission, or the units are coupled in serial communication). When coupon data are received by Mankovitz's portable data coupon, the data are

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placed in a temporary memory buffer. Once the buffer is full, the oldest data are overwritten. The user can access data in the temporary buffer using the read key, and save specific coupon data using the save key, to prevent the coupon data from being overwritten. Undesired coupons can be discarded using the cancel key. Note that a user cannot "scroll" through a list of data stored in the temporary buffer. As described by Mankovitz, a user accesses a first coupon using the read key, and then must decide to save or cancel that coupon before being able to access the next coupon (by again using the read key), until all the coupons in the temporary buffer have been moved to a protected buffer or cancelled.

To store coupon data, applicant's electronic coupon must be in the storage mode, which is selected with the recited mode key. Otherwise, any coupon data transmitted by the decoder are ignored. To review stored coupon data, the user must use the mode key to select the redeem mode. Then, a list of coupon data is displayed, and the user uses the up and down buttons to scroll through the list. Specific coupons can be selected for display as bar codes for redemption, and then can be deleted or can simply be selected for deletion, to preserve memory resources. The set-up mode described by applicant enables the user to select specific items from a products/services menu. The electric coupon will then only store coupon data relating to those products and services selected in the set-up mode. Mankovitz does not teach any equivalent functionality, but instead teaches that ALL coupon data received from the decoder/controller are stored (in a temporary buffer). This characteristic requires the user to regularly look at the data, to ensure that a desirable coupon is not overwritten by new data. Mankovitz specifically describes beeping and timing functions that are used to alert a user that the contents of the temporary buffer should be reviewed. The set-up mode described by applicant ensures that only coupons of interest will be stored.

The Examiner's assertion that Mankovitz discloses a set up mode is not well founded. The section of Mankovitz cited by the Examiner (column 7, lines 55-60) is taken out of context. What is being disclosed by Mankovitz at that point in the reference is that a remote control unit may be used to control the unit that decodes data from the VBI of a video signal. Mankovitz specifically teaches that the VBI can include more than just coupon data (column 7, line 5-8). The data in the VBI can even include coupon data that are desirably transmitted to more than one portable data coupon. A processor in the controller that decodes the data in the VBI is used to determine the portable data coupon that is to receive coupon data. The keyboard of a remote control unit is used to input the ID number of a specific portable data coupon, and the ID is transmitted to the processor controlling the decoder/controller that processes the video signal. The processor then evaluates the data from the VBI, and sends it to the appropriate device.

Such a process is distinctly different than the set-up mode described by applicant. Significantly, the set-up mode described by applicant is accessed using the mode key on the

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electronic coupon, whereas the process in the cited art that is referred to by the Examiner is accessed by a key of a totally separate device and is not based on a menu of goods and services, as defined by applicant. An applicant is allowed to be his own lexicographer. In the specification of the present case, applicant has recited a "set-up mode" and clearly defined the meaning of the set-up mode. Accordingly, it is improper for the Examiner to arbitrarily determine that a completely different process, which is executed not in an electronic coupon, but in a decoder and a separate remote control device, is equivalent to applicant's recited set-up mode.

Mankovitz's portable data coupon does not employ a storage mode or redeem mode equivalent to that recited in applicant's claims. Furthermore, Mankovitz does not teach or suggest any functionality similar to the recited set-up mode. The key strokes and navigation required of a user are distinctly different in the prior art device and in applicant's claimed device. There is no suggestion in the cited art to modify Mankovitz's portable data coupon to employ a redeem mode, a storage mode, and a set-up mode, as described by applicant, and to include a recited mode key. Nor is there any evidence that any problem was recognized in the art, which could be solved by modifying Mankovitz in such a manner.

Even if the Mankovitz and Small were combined in the manner suggested by the Examiner (and as described in detail above, there appears to be no motivation other than hindsight for such a combination), there is simply no basis to conclude that it would have been obvious to modify the key configuration described by Mankovitz to achieve the recited mode key. Accordingly, the rejection of Claims 9 and 10 under 35 U.S.C § 103 as being obvious over Mankovitz in view of Small should be withdrawn.

Claims 18 and 19 Further Distinguishable over Mankovitz/Small Combination

Claims 18 and 19 recite steps related to the set-up mode described above. With respect to Claim 18, the Examiner argues that transferring coupon data from a temporary buffer to a protected buffer is equivalent to *displaying a set-up menu from which a user can select coupon-types for storage.* However, Mankovitz does not disclose a set up menu that includes a plurality of coupon types. As described above, all coupon data transmitted from the controller/decoder are stored in Mankovitz's temporary memory. Then, the user of Mankovitz's portable data coupon must use the read key to look at each coupon individually and elect to save or delete that coupon (using the save and delete keys). No menu is provided to the user, just individual coupons, one by one. Furthermore, Mankovitz does not teach or suggest coupon-types that are selectable using the portable data coupon. Although Mankovitz teaches that the processor in the controller/decoder can send coupon data to specific portable data coupons that have been selected using their unique IDs, Mankovitz does not teach or suggest that the processor in the controller/decoder is selecting coupons based on their types. In any event, once coupon data has been received by a specific portable data coupon, there is simply

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no disclosure in Mankovitz that any specific coupon-types can be selected. The recited coupon types clearly refer to the menu of goods and services described in applicant's specification. Mankovitz makes no disclosure that a user can select a specific type of goods, such as tires, and that all coupons corresponding to that type of good will be saved. Mankovitz teaches that a user must review each coupon individually and either save it or delete it.

Thus, there is simply no basis to conclude that it would have been obvious to modify the storage method described by Mankovitz (read, save, or delete each coupon individually) to achieve the recited storage method based on a menu of coupon types. Accordingly, the rejection of Claims 18 and 19 under 35 U.S.C § 103 as being obvious over Mankovitz in view of Small should be withdrawn.

Patentability of New Claims

New Claim 24 recites a system similar to that recited in Claim 1, but in which the decoder is part of the electronic coupon. As discussed above, the cited art does not suggest an electronic coupon that includes an integrated decoder. Claim 24 further recites means for enabling the decoded coupon data to be accessed by a user or an external device. The specification clearly describes such means as including a display and a magnetic strip (page 10, lines 14-16). New Claim 25 recites such a readable magnetic strip. The cited art does not teach or suggest an electronic coupon including a readable magnetic strip.

New Claim 26 recites a system similar to that recited in Claim 1, with additional detail relating to specific function implemented by the processor. Those functions include enabling a user to select a storage mode or a redeem mode. New Claim 27 recites that the processor enables a user to select a set-up mode, in which coupon types can be selected, such that only decoded coupon data that correspond to a selected coupon type are stored in the memory. As discussed above, the cited art does not teach or suggest equivalent storage, set-up or redeem modes.

New Claim 28 recites a method for delivering and storing coupon data for an electronic coupon using the horizontal overscan portion of a video signal, using the electronic coupon to decode the coupon data. As discussed above, the cited art does not suggest using an electronic coupon that includes an integrated decoding capability. Claim 29 recites the additional steps of enabling a user to select from among a plurality of coupon types, evaluating the extracted coupon data and storing only extracted coupon data that matches a selected coupon type. The cited art does not disclose the recited coupon types and evaluating each decoded coupon, so that only coupons matching a selected type are stored.

New Claim 30 recites a method for delivering and storing coupon data for an electronic coupon using the horizontal overscan portion of a video signal. An electronic coupon enables a user to select a storage mode or a redeem mode. Claim 30 is patentable for the same reason as Claim 26, as described above.

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For the reasons set forth above, this application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is asked to telephone applicant's attorney at the number listed below.

Respectfully submitted,

Ron Anderson

Ronald M. Anderson
Registration No. 28,829

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Director of Patents and Trademarks, Arlington, VA 22202, on February 11, 2003.

Kathy L Parker

Date: February 11, 2003
RMA/MCK:

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MARKED-UP VERSION OF THE AMENDMENTS

Amendment to the Specification

In the Specification:

Please amend the specification as follows:

On Page 8, the paragraph beginning at line 12 should be amended as shown below.

In an exemplary embodiment of the electric coupon, a products/services menu could be stored in either a non-volatile memory **204** or in a Read Only Memory component (not shown) of the controller. In either case, the user can enter set-up mode (or any other mode) by pressing the MODE key **212** until the LCD display **210** indicates that the set-up mode is selected. When the set-up mode is selected on the LCD display **210**, the user can press the SELECT key **[214]** **218** to actually place the electronic coupon in set-up mode.

Amendment to the Claims

In the Claims:

Please amend Claim 3 as follows:

3. (Amended) The system of Claim 1, wherein the electronic coupon further comprises a Liquid Crystal Display (LCD) [display] for displaying the coupon representation.

Please add new Claims 24-30 as follows:

--24. A system for decoding and storing coupon data that are encoded in a horizontal overscan portion of a video signal, the system comprising:

an electronic coupon comprising:

a decoder adapted to receive the video signal, said decoder processing video signals thus received to decode coupon data that are encoded in the horizontal overscan portion of the video signal;

a processor logically coupled to the decoder, such that the coupon data decoded by the decoder are available to the processor;

a memory logically coupled to the processor in which the coupon data decoded by the decoder can be stored; and

means to enable the coupon data decoded by the decoder to be accessible to at least one of a user and an external device, said means being logically coupled to the processor.

25. The system of Claim 24, wherein said means reads the coupon data that are magnetically stored.

26. A system for decoding and storing coupon data that are encoded in a horizontal overscan portion of a video signal, the system comprising:

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a decoder adapted to receive the video signal, said decoder processing video signals thus received to decode coupon data that are encoded in the horizontal overscan portion of the video signal;

an electronic coupon comprising:

a receiver adapted to receive decoded coupon data transmitted by said decoder;

a memory for use in storing the coupon data decoded by the decoder;

a display enabling a user to view the coupon data decoded by the decoder;

at least one control key to selectively control a display of coupon data decoded by the decoder; and

a processor logically coupled to said receiver, to said memory, to said display, and to said at least one control key, said processor enabling a user to selectively manipulate the decoded coupon data received from the decoder by the receiver, said processor implementing a plurality of functions, including:

enabling a user to manipulate said at least one control key to select a storage mode, such that when the storage mode is selected, decoded coupon data received by said receiver are stored in said memory; and

enabling a user to manipulate said at least one control key to select a redeem mode, such that when the redeem mode is selected, decoded coupon data stored in said memory are presented to a user on said display as a list that a user can scroll through by manipulating said at least one control key.

27. A system for decoding and storing coupon data that are encoded in a horizontal overscan portion of a video signal, the system comprising:

a decoder adapted to receive the video signal, said decoder processing video signals thus received to decode coupon data that are encoded in the horizontal overscan portion of the video signal;

an electronic coupon comprising:

a receiver adapted to receive decoded coupon data transmitted by said decoder;

a memory for use in storing the coupon data decoded by the decoder;

a display enabling a user to view the coupon data decoded by the decoder;

at least one control key to selectively control a display of coupon data decoded by the decoder; and

a processor logically coupled to said receiver, to said memory, to said display, and to said at least one control key, said processor enabling a user to selectively manipulate the decoded coupon data received from the decoder by the receiver, said processor implementing at least the function of enabling a user to manipulate said at least one control key to select a set-up mode,

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such that when the set-up mode is selected, a user is presented with a menu comprising a plurality of coupon types that a user can select by manipulating said at least one control key, so that said processor evaluates any decoded coupon data received by said receiver, and decoded coupon data that corresponds to a selected coupon type are made available to be stored in said memory, and any decoded coupon data received by said receiver that does not correspond to a selected coupon type are not made available to be stored in said memory.

28. A method for delivering and storing coupon data for an electronic coupon using the horizontal overscan portion of a video signal, the method comprising the steps of:

providing an electronic coupon;

receiving the video signal during a transmission session;

extracting coupon data from the horizontal overscan portion of a video signal;

decoding coupon data that are encoded in the horizontal overscan portion of the video signal with the electronic coupon; and

storing the coupon data decoded by the decoder.

29. A method for delivering and storing coupon data using the horizontal overscan portion of a video signal, the method comprising the steps of:

providing an electronic coupon;

receiving the video signal during a transmission session;

extracting coupon data from the horizontal overscan portion of a video signal for input to the electronic coupon;

enabling a user to select at least one coupon type from a plurality of different coupon types, a selected coupon type corresponding to subject matter of interest to the user;

evaluating the extracted coupon data with the electronic coupon; and

if the extracted coupon data matches the selected coupon type, then storing the extracted coupon data, and otherwise, not storing the extracted coupon data.

30. A method for delivering and storing coupon data using the horizontal overscan portion of a video signal, the method comprising the steps of:

providing an electronic coupon;

receiving the video signal during a transmission session;

extracting coupon data from the horizontal overscan portion of a video signal for input to the electronic coupon;

enabling a user to select a storage mode, such that when the storage mode is selected, the electronic coupon stores extracted coupon data; and

enabling a user to select a redeem mode, such that when the redeem mode is selected, the electronic coupon displays the extracted coupon data.--

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